

moot in view of the new ground(s) of rejection." Actually, the Purdy patent was previously cited in the Official Action dated December 27, 1999 by the same Examiner, although Purdy was not applied in rejecting any of the claims at that time. Also, for the record, of the six new references (including Purdy) cited in the Form PTO-892 accompanying the Office Action of November 7, 2000, it should be noted that McDonald U.S. 5,963,245 and Lee 6,137,525 do not qualify as prior art against the subject patent application because their U.S. filing dates are September 24, 1997 and February 17, 1998, respectively, whereas the subject patent application was filed April 25, 1997, i.e. before either of those applications. Thus, the McDonald and Lee patents should be deleted from the list of prior art references. Further, it is also noted for the record that the Jacobson U.S. 6,073,034 patent is based on a series of continuation-in-part applications that have sufficiently early filing dates to qualify as prior art under 35 U.S.C. § 102 but the last continuation application does not have a sufficiently early date and, therefore, some portions of the Jacobson patent also do not qualify as prior art, i.e., those portions added by the last continuation-in-part application. Since the McDonald, Lee and Jacobson patents have not been applied in the claim rejections in the Office Action, the grounds for the rejections are not effected by these non-qualified references and they will not be discussed in the following remarks.

### THE PENDING CLAIMS

By this Amendment and Response, applicant has added a new independent claim 64 and 5 dependent claims 65-69 that are couched in somewhat different language than the other pending claims for providing a full scope of protection for applicant's invention. Claims 25, 44, 54 and 64 are the only pending independent claims. Each independent claim is directed to the invention of "A handheld portable information recording and communication device for communicating with

remotely located telephones ...” (Claims 25, 44 and 54) and Claim 64 specifically recites in the preamble that such “information recording and communication device” is a “cellular telephone” with additional capabilities. Each independent claim now requires that the entire device is in a “portable housing of a size and weight for being hand held by a person,” which clearly distinguishes applicant’s invention over previously cited and applied prior art directed to alarm systems installed in automobiles, houses, banks, airplanes, etc. such as Shamosh. Further, each independent claim now specifically requires “said cellular telephone having a microphone, a speaker and a dial pad for selective use by the person for placing and receiving person-to-person telephone calls to and from remotely located telephones” (The language of Claim 64 is slightly different but of the same scope), which clearly distinguishes applicant’s claimed invention over cited and applied references that disclose only dedicated telephone module transmitters, such as Purdy and Hess. Still further, each of the independent claims requires, in addition to requiring means for normal cell phone communication and person-to-person telephone calls, “means for activating said cellular telephone for wirelessly communicating with a specific remotely located telephone by dialing the number . . . and . . . then transmitting said images and sounds . . . to said specific remotely located telephone . . . , which is not shown by any of the cited references. Still further, independent claims 25, 44 and 54 specifically require “memory means in said housing operatively connected to said camera, said cellular telephone and said battery means for selectively storing said images . . . and said sounds” and also “means for selectively causing said stored images and sounds to be transmitted by said cellular telephone to said specific remotely located telephone” which is not shown by the references. (Still further, independent claims 25, 44 and 54 require that the memory means include “an audio recorder . . . for selectively recording audible transmissions (1) during the person-to-person telephone calls . . . and . . . (2) within a range of said housing without a telephone call” which is not

shown by any of the references. Finally, independent Claims 25, 44 and 54 specifically require "switch means for selectively and separately operating . . ." each of the operative means, such as the camera, microphone, cell phone, memory, transmission causing means, audio recorder, etc., which is not true of the cited references that have a single mode of operation and yet have been applied in rejecting applicant's claims. Independent claim 64 has similar limitations couched in different language than that which is quoted herein. Therefore, it is respectfully submitted that applicant's independent Claims 25, 44, 54 and 64 clearly distinguish over the cited references, which will be analyzed below, by reason of each of the several different elements and functions set forth above, as well as collectively. It is inappropriate for an obviousness rejection to merely select elements and functions from a variety of different references, combine and/or modify them, and then assert that they meet applicant's claims.

### **OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103**

First, counsel for applicant respectfully objects to the form of the rejections of most of the previously pending claim, (except Claims 25 and 54) as being indefinite and inappropriate obviousness rejections. Claims 44, 47, 50, 52 and 53 are rejected as unpatentable for Shamosh and Purdy in view of Hess and Reele but it is unclear from that statement (i.e., Shamosh and Purdy) whether Shamosh or Purdy is being applied as the principal reference that discloses the arrangement that is modified by a secondary reference or references to achieve the applicant's claimed invention. On page five, last six lines and page six, first seven lines of the Office Action, it would appear that the intended rejection is "Shamosh in view of Purdy . . .", but the Office Action simply is unclear. Similarly, the rejection of Claims 49 and 63 (Paragraph Nos. 6 and 7 of the Office Action) are rejected over Shamosh and Purdy in view of other references whereby it is indefinite and improper

as to which reference is the primary reference that is to be modified. Thus, the rejections should be withdrawn or restated in the manner intended by the Office Action for supporting the rejections.

For a proper and supportable claim rejection under 35 U.S.C. § 103 for obviousness, it is the obligation of the Examiner to establish a *prima facie* case of obviousness that requires three basic criteria and, further, the Examiner has the burden of establishing that the prior art has some suggestion of the desirability of doing what the inventor has done, i.e., not just that each of the elements or functions defined by the applicant's claims may be found somewhere in an assortment assorted of prior art references. Specifically, these requirements are set forth in Section 706.02(j) of the Manual of Patent Examining Procedure as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Applicant respectfully asserts that the rejections based on the references that have been applied in the Office Action do not meet the three criteria required for a *prima facie* case and, in particular, that the burden of establishing that the prior art shows a suggestion of the desirability of

combining the references to achieve applicant's claimed invention has not been met. The new principal reference is Purdy which is directed to a "Personal Data Collection and Reporting System," as set forth in the title, that is merely useable by an individual to collect and transmit video information to a central station, not as a cellular telephone for normal personal use which has a plurality of additional features. Similarly, Shamosh (which apparently is another principal reference being applied to some of the claims) is a "Security Protection System and Method," as the title states, that is permanently installed in an automobile, airplane, bank or home (Figs. 3-6) that has absolutely no relationship to either the portable personal data unit of Purdy or applicant's cellular telephone with a plurality of additional functions, whereby it is clear that there is no "suggestion or motivation" in the references "to modify the reference or to combine reference teaching" as required by the first criteria for establishing a *prima facie* case of obviousness. Further, there is no indication that there is any "reasonable expectation of success" in creating applicant's device by using the devices or systems of either Purdy or Shamosh as a primary reference that is modified by the teachings of another reference, whereby the second criteria of a *prima facie* case is missing. Still further, there is no "teaching or suggestion" in either Purdy or Shamosh (the primary references in all of the rejections) or the remaining references of "all the claim limitations" of applicant's claims, such as a cellular telephone usable for person-to-person telephone calls and selectively for transmitting in real time or from memory stored images and sound, much less the switches for accomplishing those functions, whereby the third criteria for establishing the *prima facie* case of obviousness is not met. Moreover, and perhaps most importantly, the Examiner has not met the burden of identifying a reference or a "line of reasoning" that provides "some suggestion of the desirability of doing what the inventor has done," as required by MPEP 706.02(j). The requirements for an obviousness rejection are clearly established and must be met rather than merely "picking and

choosing" elements and functions from a variety of different references and asserting that it would be obvious to one skilled in the art to combine those references in the manner taught and claimed by applicant, which was done in the Office Action.

As also stated in MPEP Section 2143.01 "THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION" and then sets forth the standard by quoting from the relevant cases, as follows:

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-59 (Fed. Cir. 1998)(The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F. 3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Still further, as set forth in MPEP 2141.02 "THE CLAIMED INVENTION AS A WHOLE MUST BE CONSIDERED" and in making that determination". . . it is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious" is the test. Here, there is no indication from any of the cited references and particularly not Purdy or Shamosh that applicant's claimed invention of a "hand held portable information recording and communication device" that combines a cellular telephone that is useable in a normal manner for making and receiving person-to-person telephone calls with the various other elements and functions for capturing images and sounds, transmitting the images and sounds in real time through the cellular telephone to a specific remote telephone, or storing the images and sounds for subsequently transmitting same, as required by each of applicant's independent Claims 25, 44, 54 and 64. Therefore, the obviousness rejection of applicant's claims is unsupported because the

claimed invention “as a whole” would not have been obvious, even though the Examiner may feel that each of the elements and functions are shown collectively in the prior art or would be obvious.

### THE REFERENCES APPLIED IN THE REJECTIONS

In the Office Action, two references (Purdy in view of Hess) are applied in rejecting Claim 25 and five additional references are applied in a variety of ways to reject the other claims in various combinations of four references for each claim. It is respectfully submitted that such rejections are not “obvious” combinations or modifications but rather are created with hindsight in view of applicant’s disclosure and claims. No one skilled in the art would find any suggestion to combine or modify the seven references that are directed to substantially different devices and systems in the manner set forth in the Office Action without reference to applicant’s disclosure, where by the rejections are improper.

#### Purdy 5,144,661

As noted above, Purdy is directed to a “Personal Data Correction Reporting System,” as the title states, wherein the PDU 10 may be worn by a person for transmitting images from camera 12 and sounds from microphone 14 to a central station 27 upon activating the PDU 10. The only mode of operation disclosed in Purdy is to activate only the switch (Column 4, lines 6-10) for causing the transmission of images and sounds to the central station by using a dedicated cell phone type transmitter. There is no teaching or suggestion in Purdy that the dedicated cell phone may be used for making or receiving normal person-to-person telephone calls, as required by each of the applicant’s claims, and there is no dial pad or speaker to accomplish such calls. Further, there is no reference to suggest that such a modification to Purdy would be obvious. Still further, the disclosure in Purdy of a single switch and mode of operation does not meet the limitations set forth in the last

four or five lines of applicant's independent claims 25 and 44 (and elsewhere in independent Claims 54 and 64) of a "switch means for selectively and separately operating . . ." at least six separate "means" (8 such means in Claim 44), whereby Claims 25 and 44 clearly distinguish over Purdy, and there is no secondary reference that suggests such selectively and separately operable switch means. Similarly, independent Claims 54 and 64 require separate switch means for operating the various elements, although not set forth in the last few lines of those claims. Thus, Purdy simply is not directed to a portable cellular telephone capable of normal telephone use, with a plurality of additional functions that are integrated with cellular telephone, as required by each of applicant's claims, whereby applicant's claims clearly distinguish over Purdy or any reasonable or obvious modification thereof.

**Hess 5,587,701**

Hess is directed to a ". . . portable alarm system for use in a residence, boat, cabin, office, and practically any other structure," as set forth in the first paragraph of the specification (Column 1, lines 6-9), wherein the device 10 is placed in a desired location in the structure for monitoring activities in that location and transferring information to a monitoring station 37. Hess does not disclose or suggest that the device 10 may be used as a cellular telephone in a normal manner for making and receiving person-to-person telephone calls, as required by each of applicant's claims, but rather Hess is only capable of sending an alarm to the monitoring station 37 by a cellular transceiver (Column 4, line 37). Thus, applicant's claims clearly distinguish over Hess and any combination of Purdy and Hess because neither reference discloses or suggests a cellular telephone capable of normal use for making and receiving telephone calls by the user. In rejecting Claim 25, the Office Action only applies Hess for teaching "the capability of initiating a telephone call to a

security monitor station by cellular transmission when an alarm condition is sensed" and therefore the combination of Purdy and Hess does not teach a cellular telephone for normal use or the multiple additional functions integrated with the cellular telephone that are separately and selectively operable by a plurality of switch means, whereby the rejection of Claim 25 is unsupported because not all of the elements or functions are disclosed in those references. Similarly, the disclosures attributed to those two references by the Office Action are inadequate in rejecting the remaining the remaining claims.

**Shamosh 5,144,661**

Shamosh has been applied in rejecting all of the claims except Claim 25 as disclosing ". . . a security protection system that includes a camera, a microphone and a cellular telephone (32), electrically connected in a housing (60) . . ." to apparently meet applicant's claimed "housing," but that is an improper and distorted interpretation of Shamosh and applicant's claimed "portable housing of a size and a weight for being handheld by a person." Housing 60 in Shamosh is an automobile and the other teachings in Shamosh are that the alarm system is permanently mounted in airplane 70, bank building 80 or house 90, with no suggestion that the security system may be used as a portable or handheld device, whereby Shamosh does not meet the "housing" limitation of applicant's claims. Further, Shamosh does not disclose a cellular telephone that is capable of normal use for making and receiving person-to-person telephone calls, as required by each of applicant's independent claims.

Shamosh is simply directed to an entirely different security system that would not be considered by one skilled in the art in solving the problems confronting applicant in creating a portable cellular telephone having a plurality of additional elements and functions, whereby

Shamosh is taken from non-analogous art that is inappropriate for rejecting applicant's claims.

Shamosh does not qualify as appropriate analogous prior art as defined by *in re Oetiker*, 977 Fed.2d 1443, 1446, 24 USPQ 2d 1443, 1445 (Fed. Cert. 1992):

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.”

Thus, Shamosh should be withdrawn as a reference against applicant's claims directed to a “handheld portable information recording and communication device” having a normal cellular telephone.

Further, contrary to the assertion in the Office Action, Shamosh does not show “an audio recorder . . . for selectively recording audible transmissions during the person-to-person telephone calls” or “sounds within a range of said housing without a telephone call” as required by applicant's Claims 25, 44 and 54. Applicant's audio recorder is separately and selectively operated by “switch means,” as required by the claims, whereas Shamosh discloses a system wherein both the video and audio recording must be operated simultaneously by a single unit 24 and only in response to an alarm sensor. Thus, applicant's claims distinguish over Shamosh by still other elements and functions.

#### Reele 5,893,037

Reele is applied in the Office Action as disclosing “an audio recorder means . . . having means for selectively recording audible transmissions to and from the cellular telephone” citing Column 6, lines 1-5 but there is no such disclosure at that location in the Reele patent. In any event, Reele does not teach nor suggest the ability of selectively recording “audible transmissions during

the person-to-person telephone calls” or the “sounds within a range of said housing without a telephone call” as specifically required by applicant’s claims. Further, there is no suggestion in Reele or the primary references for making the combination or modification asserted in the Office Action. As noted above, it is an inappropriate obviousness rejection to merely pick and choose elements from a variety of references to make modifications to other references if there is no suggestion or motivation to do so taught by the references, rather than by hindsight.

### **THE REMAINING REFERENCES**

Similarly, the remaining references of Villa-Real, Lehtonen and Bowen may disclose a specific element or function of applicant’s claimed invention but none of those references suggest a modification of the primary or other secondary references to include the element or function disclosed, and there is no motivation to do so, whereby the rejections for “obviousness” are unsupported and inappropriate.

### **SUMMARY**

Each of applicant’s presently pending Claims 25, 44, 47, 49, 50, 52, 53, 54, and 62-69 clearly distinguish over the cited references by reason of several claimed elements and functions that the Office Action has not even purported to find in the references. Thus, the claims are not “obvious” because each and every element and function is not found in the references as required for a *prima facie* showing of obviousness. Further, there is no suggestion in any of the references and there is no motivation for making the combinations and modifications asserted in the Office action as meeting applicant’s claims. Still further, applicant’s claimed invention is not shown “as a whole” by the references as required for an obviousness rejection, but rather the Office Action merely picks and chooses elements from a variety of references having a variety of different functions for “creating”

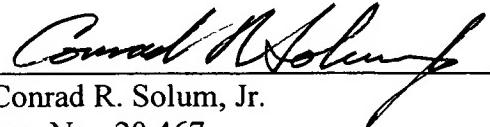
the alleged obviousness rejection, which applicant submits has been done by impermissible hindsight. Reconsideration of the rejections and a favorable action on the merits is respectfully solicited.

Respectfully submitted,

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Dated: 12/20/00

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